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JUL 26 2010

OFFICE OF PETITIONS

In re Application of :
Egan et al. :
Application Number: 09/750,766 : DECISION ON APPLICATION
Filed: December 28, 2000 : FOR
Attorney Docket No. 7000-526 : PATENT TERM ADJUSTMENT
:

This is a decision on the APPLICATION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR § 1.705 filed on October 20, 2009, requesting that the determination of patent term adjustment at the mailing of the notice of allowance be corrected from 540 days to 974 days.

The application for patent term adjustment patent is **GRANTED TO THE EXTENT INDICATED.**

The Office has updated the PALM and PAIR screens to reflect that the Patent Term Adjustment (PTA) at the time of the mailing of the Notice of Allowance is 882 days. A copy of the updated PALM screen, showing the revised determination, is enclosed.

On July 20, 2009, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date was 540 days (847 days of Office delay and 307 days of applicant delay).

The subject application for patent term adjustment was timely filed on October 20, 2009.¹

Applicants assert that a 158 day period of adjustment for Office delay should be entered because the final Office action mailed on August 25, 2006, was not mailed to the correct address, as specified in the power of attorney and change of correspondence address filed on April 6, 2006. The Office action was remailed to the new correspondence address on February 28, 2007, four months and 158 days after the filing of a reply on May 23, 2006.

Applicants further dispute the 276 day period of applicant delay from the mailing of the final Office action on August 25, 2006, to the filing of a notice of appeal on August 28, 2007. Specifically, applicants assert that the period of applicant delay is not warranted because the final Office action was not mailed to the correct address on August 25, 2006, but was remailed to applicant's correct address on February 28, 2007. Applicants assert that "[d]uring that period of time, Applicant did not fail to engage in reasonable efforts to conclude processing or examination of the application. It is asserted, therefore, that the applicant delay should be reduced by 276 days from 307 days to 31 days. Further, applicants assert that the Office did not mail an advisory action until more than six months after the date the final Office action was mailed.

A review of the record reveals that on April 6, 2006, a power of attorney and change of correspondence address was filed. However, the power of attorney and change of correspondence address were not acted on at that time, and on August 25, 2006, the final Office action was mailed to the old correspondence address. Subsequently, on February 28, 2007, the final Office action was remailed to the address indicated in the power of attorney and change of correspondence address filed on April 6, 2006.

With regards to the Office delay, a review of the application history reveals that applicants are correct. The final Office action mailed on August 25, 2006, was not mailed to the correspondence address set forth in the change of correspondence address filed on April 6, 2006, and so was not a response under 37 CFR 1.702(a)(2).

Accordingly, the Office's delay should have been calculated using the date that the final Office action was properly mailed

¹ A review of Office PALM records indicates that the issue fee was paid on October 20, 2009.

to the address specified in the change of correspondence address filed April 6, 2006, or February 28, 2007. Applicants are correct that the period of Office delay under 37 CFR 1.702(a)(2) should be increased by an additional 158 days, counting the date beginning on September 24, 2006, the day after the date that is four months after the date a response to the non-final Office action was filed, and ending on February 28, 2007, the date that the final Office action was remailed to the new correspondence address. Accordingly entry of a period of Office delay of 158 days is warranted.

With regards to the applicant delay, applicants' assertion that the period of reduction for applicant delay should be reduced by 276 days from 307 days to 31 days is incorrect.

37 CFR 1.704(b) states that an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed.

MPEP 2731 states that the period of delay is the number of days beginning on the date after the date a reply in compliance with 37 CFR 1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first. A reply under 37 CFR 1.113 is a reply to a final Office action, and a reply in compliance with 37 CFR 1.113 is a reply that cancels all of the rejected claims and removes all outstanding objections and requirements or otherwise places the application in condition for allowance. Any amendment after final that does not cancel all of the rejected claims and remove all outstanding objections and requirements or otherwise place the application in condition for allowance is not a reply in compliance with 37 CFR 1.113(c).

Following a final Office action, the period at issue is first the period it takes applicant to file a reply in compliance with 37 CFR 1.113(c). Until such a reply is filed, applicant is

subject to entry of a period of reduction for failure to engage in reasonable efforts to conclude processing or examination within the meaning of 37 CFR 1.704(b). The mailing of an Advisory Action is an indication that the reply filed did not comply with 37 CFR 1.113(a). It is not the Office's action within the meaning of 37 CFR 1.702(a)(2).

Applicants' reply on April 30, 2007, to the final office action of February 28, 2007, was not in accordance with 37 CFR 1.113(c). On August 28, 2007, three months and 92 days after the final Office action was mailed, a notice of appeal in compliance with 37 CFR 1.113(c) was filed. Accordingly, a reduction in patent term adjustment of 92 days for applicant delay is warranted for failure to engage in reasonable efforts to conclude processing or examination.

The period of reduction for applicant delay under 37 CFR 1.704(b) runs from May 29, 2007, the day after the date that is three months after the date of remailing of the Office action to the current correspondence address, to August 28, 2007, the date that a proper reply, in the form of a notice of appeal, was filed, or 92 days. Accordingly, the period of applicant delay of 276 days will be removed, and a period of applicant delay of 92 days will be entered.

The patent term adjustment is updated to 882 days $1005 (847 + 158)$ days of Office delay and $123 (307 - 276 + 92)$ days of applicant delay.

The address in the petition is different than the correspondence address. A courtesy copy of this decision is being mailed to the address in the petition. All future correspondence, however, will be mailed solely to the address of record. A change of correspondence address should be filed if the correspondence address needs to be updated.

The application is being forwarded to the Office of Data Management for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Douglas I. Wood, Senior Petitions Attorney, at (571) 272-3231.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is positioned above the printed name.

Anthony Knight
Director
Office of Petitions

Encl: Updated PALM Calculation

Cc: WITHROW & TERRANOVA, P.L.L.C.
100 REGENCY FOREST DRIVE, STE 160
CARY NC 27518

Day : Friday
Date: 7/23/2010

PALM INTRANET

Time: 14:41:31

PTA Calculations for Application: 09/750766			
Application Filing Date:	12/28/2000	PTO Delay (PTO):	847
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	307
Post-Issue Petitions:	0	Total PTA (days):	882
PTO Delay Adjustment:	342		

File Contents History					
Number	Date	Contents Description	PTO	APPL	START
108	07/23/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	342		
98	07/20/2009	MAIL NOTICE OF ALLOWANCE			
97	07/19/2009	ISSUE REVISION COMPLETED			
96	07/19/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
95	07/19/2009	CASE DOCKETED TO EXAMINER IN GAU			
94	07/19/2009	DOCUMENT VERIFICATION			
93	07/19/2009	NOTICE OF ALLOWABILITY			
92	05/06/2009	APPEAL BRIEF REVIEW COMPLETE			
91	05/06/2009	DATE FORWARDED TO EXAMINER			
90	04/14/2009	APPEAL BRIEF FILED			
89	04/14/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
88	01/23/2009	REQUEST FOR REFUND			
87	12/15/2008	NOTICE OF APPEAL FILED			
86	10/06/2008	CASE DOCKETED TO EXAMINER IN GAU			
85	10/06/2008	MAIL FINAL REJECTION (PTOL - 326)			
84	10/01/2008	FINAL REJECTION			
83	07/18/2008	DATE FORWARDED TO EXAMINER			
82	06/12/2008	RESPONSE AFTER NON-FINAL ACTION			
81	03/19/2008	MAIL NON-FINAL REJECTION			
80	03/17/2008	NON-FINAL REJECTION			
76	01/11/2008	DATE FORWARDED TO EXAMINER			
75	11/28/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
74	01/11/2008	DATE FORWARDED TO EXAMINER			
		REQUEST FOR CONTINUED EXAMINATION			

73	11/28/2007	(RCE)			
72	01/11/2008	DISPOSAL FOR A RCE / CPA / R129			
71	11/28/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
70	11/28/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
69	10/01/2007	REQUEST FOR REFUND			
68	02/06/2007	CORRESPONDENCE ADDRESS CHANGE			
67	02/07/2007	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
66	08/28/2007	NOTICE OF APPEAL FILED		276	58
65	08/28/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
64	08/30/2007	MAIL ADVISORY ACTION (PTOL - 303)			
63	08/28/2007	ADVISORY ACTION (PTOL-303)			
62	08/23/2007	DATE FORWARDED TO EXAMINER			
61	04/30/2007	AMENDMENT AFTER FINAL REJECTION			
60	02/28/2007	MAIL NOTICE OF RESTARTED RESPONSE PERIOD			
59	02/26/2007	LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES)			
58	08/25/2006	MAIL FINAL REJECTION (PTOL - 326)			
57	08/21/2006	FINAL REJECTION			
32	06/07/2006	DATE FORWARDED TO EXAMINER			
31	05/23/2006	RESPONSE AFTER NON-FINAL ACTION			
30	03/21/2006	CASE DOCKETED TO EXAMINER IN GAU			
29	02/27/2006	MAIL NON-FINAL REJECTION			
28	02/21/2006	NON-FINAL REJECTION			
27	01/03/2006	DATE FORWARDED TO EXAMINER			
26	12/23/2005	APPEAL BRIEF FILED			
25	11/10/2005	NOTICE OF APPEAL FILED			
24	10/12/2005	CASE DOCKETED TO EXAMINER IN GAU			
23	08/10/2005	MAIL FINAL REJECTION (PTOL - 326)			
22	08/08/2005	FINAL REJECTION			
21	06/02/2005	DATE FORWARDED TO EXAMINER			
20	05/23/2005	RESPONSE AFTER NON-FINAL ACTION			
19	02/25/2005	MAIL NON-FINAL REJECTION	17		15
18	02/22/2005	NON-FINAL REJECTION			
17	12/12/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			

16	12/12/2004	DATE FORWARDED TO EXAMINER			
15	10/08/2004	RESPONSE AFTER NON-FINAL ACTION		31	10
14	10/08/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
11	10/08/2004	WORKFLOW INCOMING AMENDMENT IFW			
10	06/07/2004	MAIL NON-FINAL REJECTION	830		-1
9	06/01/2004	NON-FINAL REJECTION			
8	05/10/2004	CASE DOCKETED TO EXAMINER IN GAU			
7	04/23/2004	CORRESPONDENCE ADDRESS CHANGE			
6	04/22/2004	CORRESPONDENCE ADDRESS CHANGE			
5	03/09/2001	CASE DOCKETED TO EXAMINER IN GAU			
4	02/13/2001	APPLICATION DISPATCHED FROM OIPE			
3	02/12/2001	CORRESPONDENCE ADDRESS CHANGE			
2	01/17/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	12/28/2000	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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